

Supreme Court, U. S.

FILED

SEP 28 1978

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IN THE
Supreme Court of the United States

OCTOBER TERM, 1978.

No. 78-26

PETER M. ROBERTS,

Respondent,

vs.

SEARS, ROEBUCK AND CO.,

Petitioner.

**REPLY OF SEARS, ROEBUCK AND CO. TO BRIEF IN
OPPOSITION TO ITS PETITION FOR WRIT OF
CERTIORARI TO THE UNITED STATES COURT
OF APPEALS FOR THE SEVENTH CIRCUIT.**

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I. Introduction.

In its petition for a writ of certiorari, defendant presented what it considers an objective review of the facts and evidence supported by numerous record citations. Plaintiff's so-called "factual" statement, on the other hand, is a mixed bag of innuendo, arguments and conclusions totally unsupported by and indeed contrary to the record. These misstatements and erroneous conclusions permeate each of plaintiff's arguments as well.

Defendant will not repeat the record references that unequivocally support each of its representations, for to do so would unduly burden this Court. Nor will it dwell here upon plaintiff's unwarranted attack upon the sincerity of its petition for a writ

of certiorari, other than to mention that its merit is clearly demonstrated by the decisions of this Court and the various Circuits which refused recovery under similar facts in *Lear, Inc. v. Adkins*, 395 U. S. 653, 23 L. Ed. 2d 610 (1969); *Blonder-Tongue Labs, Inc. v. University of Illinois Foundation*, 402 U. S. 313, 28 L. Ed. 2d 788 (1971);¹ *Scott Paper Co. v. Marcalus Mfg. Co., Inc.*, 326 U. S. 249, 90 L. Ed. 47 (1945); *Beckman Instruments, Inc. v. Technical Development Corp.*, 433 F. 2d 55 (7 Cir. 1970), *cert. denied*, 401 U. S. 976 (1971); *Sinclair Refining Co. v. Jenkins Petroleum Process Co.*, 99 F. 2d 9 (1 Cir. 1938), *cert. denied*, 305 U. S. 659 (1939).² Rather, defendant will only address those of the misconceptions which plaintiff claims support his specious contention that this verdict may stand, irrespective of whether his patent is invalid and irrespective of the effect of prior art on its value.

II. Argument.

A. Plaintiff Cannot Distinguish the Federal Law That Conflicts with the Decision Below.

Plaintiff's argument, in a nutshell, is that there is value to a legally valueless patent. To arrive at this erroneous conclusion he casually waives a hand at or attempts to rewrite the decisions of this and other Courts.

If plaintiff's patent is directly anticipated and disclosed to the public by prior art, it conveys nothing under the law, and defendant, although it paid \$10,000, acquired nothing of legal

1. Plaintiff's charge that defendant did not rely on *Blonder-Tongue* below is wrong. Defendant relied upon this relevant decision and quoted from it extensively before the Court of Appeals (Brief on Cross Appeal, p. 14).

2. Defendant's comment below regarding this appeal followed an earlier settlement conference with the trial court. Of course, there would be no point to this appeal if the matter had been settled, which it was not.

value. No amount of commercial expectation, as plaintiff attributes to defendant, can make it valid. Nor, as plaintiff argues, did the patent, if invalid, convey any protectable secret ancillary rights. In fact, plaintiff conceded below that he did not claim a trade secret (T. 3226-3228). Similarly, plaintiff's patent, if invalid, did not, as he argues, convey a monopoly or even freedom from patent infringement litigation. As plaintiff concedes in his brief, defendant was required to purchase the prior art Gonzalez patent (PB 10)³ when Gonzalez threatened Sears with an infringement lawsuit (DX 16, 17, 18, T. 2266-2273). For these reasons alone the invalidity of plaintiff's patent is not only relevant but is a basic issue that cannot be ignored.

Plaintiff suggests that defendant considered his patent valid when it acquired it. But that factual misconception, even if true, which it is not, cannot magically render an invalid patent valid. The question of patent invalidity is, as plaintiff concedes, one of law (T. 3102-3104). Certainly the defendants in *Lear Inc. v. Adkins* and its progeny also initially considered valid the patents they acquired or they would not have purchased them. Nevertheless, those defendants were not barred from later asserting patent invalidity when they discovered that their initial belief was wrong, and defendant cannot be barred here. Indeed, the so-called estoppel concept now advanced by plaintiff was expressly rejected by those decisions. Similarly, nothing in those decisions even remotely suggests, as plaintiff argues, that they do not apply now because defendant is the owner of the patent. Indeed, as set forth in defendant's petition, several of them were expressly applied and others implicitly apply to a patent owner. See, for example, *Sinclair Refining Co. v. Jenkins Petroleum Process Co.*, 99 F. 2d 9 (1 Cir. 1938), *cert. denied*, 305 U. S. 659 (1939); *Beckman Instruments, Inc. v. Technical Development Corp.*, 433 F. 2d 55 (7 Cir. 1970), *cert. denied*,

3. The letters "PB" refer to plaintiff's brief in opposition to defendant's petition, "PX" to plaintiff's trial exhibits, "DX" to defendant's trial exhibits, "R" to the record on appeal and "SA" to defendant's Supplemental Appendix on appeal.

401 U. S. 976 (1971). Clearly defendant was improperly barred from proving patent invalidity for these reasons also.

Equally fr^ustrating is plaintiff's argument that, under these decisions, defendant is prevented from proving the invalidity of his patent until it repudiates the patent.⁴ The speciousness of this argument is clearly demonstrated by the Seventh Circuit's decision in *Beckman Instruments, Inc. v. Technical Development Corp.*, 433 F. 2d 55 (7 Cir. 1970), *cert. denied*, 401 U. S. 976 (1971). There, the Court specifically rejected plaintiff's contention, as follows:

Defendants attempt to distinguish the doctrines of licensee estoppel and estoppel by marking by suggesting that the former is based on principles of contract law, while the latter has its basis in equity. *But defendants' arguments in support of each of these doctrines sound very similar, namely, that it is unfair for licensees to use the patent and accept the benefits of the license and then attack the validity of the patent. However, the Supreme Court in Lear rejected such arguments when applied to the licensee estoppel doctrine, and we think the Court's reasoning extends to the doctrine of estoppel by marking as well. Defendants have not suggested any reason why the 'strong federal policy' in favor of encouraging challenges to invalid patents should not apply when there has been marking with the patent number. Perhaps it is true that such marking provides the licensee with additional protection from competitors, thus making it seem all the more unfair to allow him to repudiate his obligations. However, it must be noted that the Supreme Court in Lear . . . held that patent invalidity must be made a complete defense to the obligation to pay royalties. We cannot say that the additional consideration or 'benefit' flowing to the licensee who marks his products with the patent number is sufficient to make the Lear case and its policy rationale inapplicable. 433 F. 2d at 59 (emphasis added).*

4. It is appropriate to point out that plaintiff misstates the facts when he charges that defendant continues to publicly assert the validity of the patent. The record is clear that defendant removed all patent numbers from its wrench in October, 1971 (R. 59). Plaintiff relies on an isolated retail merchandise list that is not and never has been disseminated to the public (T. 1434-1436, 1609).

Such an estoppel argument was likewise rejected by the Court in *American Sterilizer Co. v. Sybron Corp.*, 526 F. 2d 542 (3 Cir. 1975), wherein it held that a licensee's failure to terminate the license agreement did not prevent its challenge to the validity of the underlying patent. *Id.* at 545-547. *See also, PPG Industries, Inc. v. Westwood Chemical, Inc.*, 530 F. 2d 700, 707 (6 Cir. 1976), *cert. denied*, 429 U. S. 824 (1976).

However, even if, as plaintiff asserts, repudiation was necessary, it is clear that defendant repudiated the patent in written answers to interrogatories as early as September, 1971, immediately upon its discovery of the crucial prior art Carpenter patent, and repeatedly thereafter in other responsive pleadings (R. 19, 37, 83, 110). In view of defendant's repudiation as early as 1971, under plaintiff's own theory, the jury award of profits or damages from 1971 through 1976 was improper and requires a new trial.⁵

Plaintiff is less than candid with this Court when he suggests that defendant delayed repudiating the patent to prevent a prompt decision on patent invalidity. What plaintiff understandably does not mention is that he, rather than defendant, prevented a prompt resolution of the issue by repeatedly arguing in the trial court that patent invalidity should not be resolved. Plaintiff's arguments to bar a trial on the validity issue were regularly rejected by the two judges to whom the case was assigned before its reassignment to the trial court shortly before trial (R. 40, 56, 82). It was only after the trial was nearly completed that defendant learned for the first time that it would not be permitted to prove that the patent was invalid (T. 2567-2569, 2976). By then, of course, it was too late to rely on any

5. Rather than jealously guard these worthless patents, as plaintiff argues, defendant has previously voluntarily prepared, executed and tendered its reassignments of *any and all* rights and patents obtained under and pursuant to its written agreement with plaintiff. Plaintiff rejected these reassignments (Transcript of hearings of May 26, 1978 and June 19, 1978), presumably on the basis that the patents are as worthless to him as they are to defendant.

of the other procedures which plaintiff suggests would have been appropriate.⁶

The decisions that plaintiff relies upon for this so-called estoppel concept simply and plainly do not support his argument for in none of them was a party precluded from litigating the issue of patent invalidity as defendant has been precluded here. Thus, contrary to plaintiff's assertion, *Moraine Products v. ICI America, Inc.*, 538 F. 2d 134 (7 Cir. 1976), *cert. denied*, 429 U. S. 941 (1976), is an antitrust decision that held that a patentee could recover money damages where he was prevented from commercializing his idea because of an illegal conspiracy by others in violation of the antitrust laws.

⁶ Similarly, *Kraly v. National Distillers and Chemical Corp.*, 319 F. Supp. 1349 (N. D. Ill. 1970), *aff'd*, 502 F. 2d 1366 (7 Cir. 1974), expressly approved the *Beckman* rule and only held that defendant, as a party to a settlement agreement in a patent infringement lawsuit, could not avoid his express contractual royalty obligation under that settlement agreement while at the same time accepting the benefit of the same agreement. Moreover, this decision does not apply here because it is undisputed that defendant discharged each of its contractual obligations under its agreement with plaintiff, including its agreement to pay plaintiff a \$10,000 royalty (T. 380-382, 407, 533-534).

The decision in *Troxell Manufacturing Co. v. Schwinn Bicycle Co.*, 465 F. 2d 1253 (6 Cir. 1972), and 489 F. 2d 968 (6 Cir. 1973), *cert. denied*, 416 U. S. 939 (1974), is equally inapplicable for that decision merely holds that a licensee who has previously paid a royalty may not recoup that royalty payment after the patent has later been declared invalid. Similarly, *Heltra, Inc. v. Richen-Gemco, Inc.*, 395 F. Supp.

6. One of these procedures advanced by plaintiff suggests that defendant could have litigated a patent infringement lawsuit against another to obtain a more expeditious resolution of the patent's invalidity. This argument is no more than a suggestion that defendant speciously and maliciously prosecute a claim that it believes is meritless—a clear abuse of the judicial system.

346 (D. S. C. 1975), *rev'd on other grounds*, 540 F. 2d 1235 (4 Cir. 1976), simply rules that a determination of patent invalidity will not affect a royalty obligation under an agreement that expressly required the royalty payment regardless of the validity of any patent that would ultimately issue.

Finally, *Kewanee Oil Corp. v. Bicron Corp.*, 416 U. S. 470, 40 L. Ed. 2d 315 (1974), does not support plaintiff. In *Kewanee* this Court merely ruled that an unpatentable idea may still be a trade secret which, if misappropriated, will support a cause of action for damages. This decision is not applicable here because plaintiff does not claim a trade secret (T. 3226-3228) for the obvious reason that his idea was completely disclosed by prior art. Clearly, the Court of Appeals' and plaintiff's reliance on this decision is misplaced.

Even if the issue of patent validity was initially somehow irrelevant, which it was not, it became relevant because plaintiff made it relevant. His argument that he did not offer evidence on this issue is refuted by his own brief, for he concedes that he argued the validity of his patent to the jury (PB 12, T. 3300, 3312-3314, 3316, 3317, 3322, 3330, 3331, 3337-3341, 3343, 3347, 3351-3352, 3354, 3358-3361, 3362-3364, 3421-3422, 3432A, 3435-3436) and devoted a substantial portion of his examination of his own witnesses toward developing the novelty of his invention (T. 195-198, 302-303, 378-380, 613 *et seq.*, 732 *et seq.*, 736-738, 1441-1443, 1448, 1463, 1513-1516, 1517-1518, 1521, 1529, 2302). Indeed, he argues its novelty even now (PB 26-33).

Having received evidence of the prior art when proffered by plaintiff, and having time and again expressed itself with respect to the relevancy of evidence of the prior art (T. 65, 96-99, 101, 105-109, 461-463, 465, 490, 493-495, 508-509, 624, 1190-1192, 2164, 2197-2198, 2202-2203, 2401-2402, 3163-3165, 3188-3190, 3360-3361), the trial court nevertheless excluded such evidence when proffered by defendant on the erroneous basis that defendant was unaware of and did not rely on the

prior art when it acquired plaintiff's patent (T. 2409-2410, 2425-2429). Thus, it excluded from evidence the prior art Carpenter patent and all of defendant's testimony and exhibits thereon (T. 2409-2413, 2416, 2425-2429, 2600) notwithstanding the fact that it had received evidence from plaintiff regarding this same patent (T. 732-738). This procedure denied defendant its due process right to a fair trial and alone requires that a writ of certiorari issue. Indeed, even if it could be said that defendant's unawareness of prior art patents was a proper basis for their exclusion from evidence, the exclusion was still error as to seven prior art patents that defendant clearly relied upon when it negotiated with plaintiff (PX 28, 34, DX 8, 9, 14, T. 2146-2157, 2232-2233, 2242, 2317-2318).

Plaintiff's misconception of the issue reaches a new dimension when he argues that the jury considered and rejected defendant's argument that the prior art Gonzalez patent invalidated plaintiff's patent (PB 5). Although the validity or invalidity of plaintiff's patent over Gonzalez is clearly a question of law, when the trial court refused to consider this question, defendant, as a last alternative, tendered jury instructions thereon (T. 3101-3104). How can it be said that the jury considered this prior art Gonzalez patent when plaintiff opposed and the trial court rejected each and every jury instruction tendered by defendant regarding the Gonzalez patent, its relationship to plaintiff's patent and the validity or invalidity of plaintiff's patent (T. 3101-3104)?

For the foregoing reasons, and each of them, defendant respectfully requests that a writ of certiorari issue.

B. Plaintiff's Patent Is Invalid as a Matter of Law, the Trial Court Erred When He Refused to Rule on This Question and This Court Should Now Rule Thereon.

In its Brief on Cross Appeal defendant irrefutably demonstrated the invalidity of plaintiff's patent by reference to prior patents issued to Eugene R. Carpenter in 1928 (DX 29, SA

83-115) and Victor E. Gonzalez in 1965 (DX 28, SA 42-82, DX 35, 36, 37), the testimony of plaintiff's own patent lawyer (T. 724-725) and the applicable law.

1. Plaintiff's Patent Is Invalid Over Carpenter.

Simply ignoring the Carpenter structure and the unequivocal language of that patent, plaintiff erroneously states that the Carpenter wrench (1) applies to a "brace" rather than a wrench, (2) contains no head or stud extending from a side surface of the head, (3) has no recess for selective alignment, (4) has a ball that rides upon a leaf spring rather than a surface of the pin for the purpose of retaining a socket and (5) requires a two-handed operation to release the socket (PB 27). The speciousness of each of these statements is clearly demonstrated by the Carpenter structure and by the express language of the Carpenter patent. (For the convenience of the Court, reproductions of each of defendant's chart exhibits of the Carpenter, Gonzalez and plaintiff's structure are affixed hereto.)

Plaintiff's assertion that the Carpenter patent applies to a "brace" rather than a socket wrench is refuted by the following language of the Carpenter patent:

My invention relates to improvements in wrenches of that type which comprise a handle member having socket members detachably and reversibly connected with the handle, and the invention consists in the combinations, constructions and arrangements herein described and claimed. (SA 85, ll. 1-7, emphasis added.)

See also SA 86, ll. 128 ff.; 87, 1.3.

Equally erroneous is plaintiff's assertion that Carpenter does not disclose a head. A head is merely "the end of something regarded as the upper or higher end" or the "uppermost extremity of an object" or "the front or foremost part of something." Webster's *Third New International Dictionary*, p. 1042, defs. 7a, 12 and 23 (1971). It is clear from these common dictionary definitions that the head of the handle on the Carpenter wrench is the upper and foremost end of the handle

(colored green on each of defendant's chart exhibits). Plaintiff's casual denial of this basic proposition is astonishing.

Plaintiff's next contention, that the Carpenter wrench does not provide for a stud extending from a side surface of this head, also is belied by the Carpenter structure and the language of the Carpenter patent. The Carpenter stud, like the stud on plaintiff's structure, is colored brown on each of defendant's chart exhibits. The purpose of the stud, referred to by Carpenter as a "supporting end member" or "out-turned end portion" (SA 85, ll. 48-60), and referred to by plaintiff as a "driver" or "stud" (SA 19, col. 1, ll. 40-44), is to drive a socket, which plaintiff concedes Carpenter accomplishes (PB 27). Both plaintiff and Carpenter describe the stud as a hexagonal or other non-circular configuration. For example, Carpenter describes the stud as follows:

The *non-circular* portion of each of these supporting end members of the wrench handle is straight for its entire length, and preferably is *hexagonal* in cross-section configuration (SA 85, ll. 55-60, emphasis added).

Plaintiff defines his stud as follows:

The stud 14 is ordinarily square, *hex*, etc., but can be of any *non-circular* shape in order to drive a socket 16, *these all being well-known in the art* (SA 19, col. 1, ll. 41-43, emphasis added).

Similarly spurious is plaintiff's assertion that the Carpenter tool does not have a recess for selective alignment. The Carpenter recess, referred to by Carpenter as a "cavity" (SA 86, ll. 15-17), is clearly disclosed by the number 18 on the Carpenter structure, colored white on defendant's chart exhibits, and Carpenter expresses the function of this recess as follows:⁷

The pin 9 is provided at a slight distance from its inner end with a *cavity* 18 which is formed in the side of the

7. "Cavity" and "recess" are universally recognized to be synonymous terms. See, e.g., Roget's *Thesaurus*, pp. 82, 392 (Garden City Books Edition, 1961).

pin 9 that is next to the ball latch member 6. The *cavity* 18 is sufficiently large to partially *receive* the ball member 6 when the *cavity* 18 is in register with the opening 5. The action of the spring tends to maintain the pin 9 in its outermost position in the bore 4 and at such time the cavity 18 is located out register with the opening 5 as shown in Fig. 2. The *cavity* 18 intersects the slot 14 as shown and when it is desired to *release* the socket member 8 from the associated end portion 2 of the wrench handle, the pin 9 is forced axially inward against the action of spring 13 until the engagement of the outer end of the cavity 11 with a guiding and retaining member 19 prevents further inward movement of the pin 9. The *cavity* 18 then will be disposed in register with the inner end of the opening 5 and the ball latch member 6 will move inwardly by force in the opening 5 out of the groove 7 so the ball 6 [sic socket member 8] will move partially into the cavity 18 (SA 86, ll. 11-36, emphasis added).

It is also clear from the foregoing description that when the ball enters the cavity it will no longer secure the socket member and the socket member will be released from the ratchet or other handle and will fall by gravity. See also SA 86, ll. 108-114; 87, ll. 7-8, 27-28, 49-50, 66-72, 79-80, 89-119. Thus, plaintiff's conclusion that the Carpenter wrench is a two-handed tool designed only to retain a socket is therefore also false. What plaintiff describes as a recess, Carpenter describes as a cavity, but they are the same thing and serve the same purpose.

Finally, plaintiff's assertion that the Carpenter ball rides on a leaf spring rather than a surface of the pin is incorrect. Plaintiff ignores the express language of the Carpenter patent which provides:

[In the locking position] *the inner-end portion of the pin will support the ball latch member 6* in its outermost latching position in the opening 5 and the associated socket member 8 will be held in place on the end member 2 of the wrench handle (SA 85, ll. 95-101, emphasis added).

Moreover, the purpose of the leaf spring is not, as plaintiff concludes, to retain a socket, but rather, as Carpenter expressly provides, its purpose is to ride underneath the ball detent to prevent the ball from becoming frozen or stuck in the recess as follows:

This inward movement of the ball latch member 6 is effected against the action of the arm 15 of the spring member 15-16 *which is not sufficiently strong to maintain the ball latch member 6 in its latching position but which will tend to prevent the ball latch member 6 from sticking or becoming frozen in place in the cavity 18. . . .* It therefore, will be apparent that clogging of the operating and latching parts of the device will be practically prevented so that uniformity of the operation of the latching mechanism for holding the socket member 8 on a supporting end portion of the wrench handle will be assured (SA 86, ll. 36-59, emphasis added).

As disclosed by the foregoing, under the Carpenter patent, as in plaintiff's patent, it is the pin rather than the leaf spring that supports the ball in its locking position. As is also clear from the foregoing, the Carpenter leaf spring does not and cannot support the ball in its outward looking position but is a refinement that prevents the ball from becoming frozen in the recess.

2. Plaintiff's Patent Is Also Invalid Over Gonzalez.

Plaintiff also argues that Gonzalez (1) provides only a retention function, (2) has no recess in the pin and (3) does not carry the ball detent on a surface of the pin but rather on a flange of the pin (PB 27). Each one of these contentions is specious.

That Gonzalez provides a release function as well as a retention function is clearly demonstrated by the language of his patent which states:

A manually operable button or head permits the rod to be moved in the shaft for *releasing* the ball. The ball in

its outermost position in the bore engages in a recess of a tool removably mounted on the shaft. *When the ball is in its innermost position the tool is released and can be removed from the shaft.* (SA 45, l. 20, emphasis added.)

See also SA 46, col. 4, ll. 31-35. Indeed, plaintiff's own expert witness repeatedly conceded at trial that when the Gonzalez pin is depressed, the ball falls into a recess and the socket member is thereby released (T. 2667, 2682-2783, 2784, 2787).⁸

The Gonzalez structure, as does plaintiff's structure, discloses a pin with a flange as an integral part thereof (blue),⁹ a ball (red) that rides on the top of the flange and a recess (white) defined by the flange portion of the pin and the head of the ratchet. The Gonzalez patent expressly provides for this recess to release a socket member as follows:

Shaft 46 is axially aligned with rod 36 so that when head 50 and shaft 46 are pressed inwardly of the casing, as shown in Fig. 3, the rod 36 is moved axially to *release* the ball so that it can be moved radially inward of shaft 14 out of *recess* 33 and tool 30. If the pressure on end 50 is relaxed the rod 36 will normally tend to move to locking position in which flange 38 engages the ball 28. (SA 45, col. 2, ll. 51-58.)

Thus, when the rod or pin is moved axially, the ball is released from the flange and falls into a recess.

Finally, plaintiff suggests that the existence of a flange as an integral part of the Gonzalez pin, rather than a "cammed surface," avoids an anticipation by Gonzalez. This argument is misplaced for the simple reason that plaintiff's patent does not claim as invention the absence of a flange or existence of a

8. Significantly, it is not what these prior patents claim but what the patents, their specifications and their drawings disclose that is relevant, for if each of the elements of plaintiff's claim is disclosed by them by any means whatsoever, plaintiff's patent is invalid.

9. Plaintiff's own witness concedes that this flange is or may be an integral part of the Gonzalez pin (T. 2789).

"cammed surface." Under the language of his claim a flange or, alternatively, a "cammed surface," may or may not be included.¹⁰ Thus, in this connection plaintiff only claims as invention a detent that is "normally engaged with a surface of the pin." It is clear from the Gonzalez structure that the detent is so engaged.

Thus, whether one considers the prior art patents, the testimony of plaintiff's witnesses, or the testimony of defendant's witnesses, individually or collectively, it cannot be disputed that each and every element of plaintiff's claim is found in the prior art and thus plaintiff's patent is directly anticipated by prior art.¹¹

10. It is well settled that the validity of plaintiff's patent may only be determined by the unambiguous language of his claim and not by reference to drawings or patent specifications. *Maclaren v. B-I-W Group, Inc.*, 535 F. 2d 1367 (2 Cir. 1976), *cert. denied*, 429 U. S. 1001 (1976); *Phillips Industries, Inc. v. State Stove and Manufacturing Co., Inc.*, 522 F. 2d 1137 (6 Cir. 1975), *cert. denied*, 423 U. S. 1055 (1976); *Borg-Warner Corp. v. Mall Tool Co.*, 217 F. 2d 850 (7 Cir. 1954), *cert. denied*, 349 U. S. 946 (1955); *Dickstein v. Seventy Corp.*, 552 F. 2d 1294 (6 Cir. 1975), *cert. denied*, 423 U. S. 1055 (1976); *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.*, 336 U. S. 271, 93 L. Ed. 672 (1948); *Bela Seating Co. v. Poloron Products, Inc.*, 297 F. Supp. 489 (N. D. Ill. 1968), *aff'd*, 438 F. 2d 733 (7 Cir. 1971), *cert. denied*, 403 U. S. 922 (1971). For similar reasons, any testimony from plaintiff's witnesses regarding the superiority of plaintiff's patent for self-adjustment for wear or different socket size because of the absence of a flange is irrelevant to the validity of plaintiff's patent.

11. Certainly, any improvement over prior art was also obvious as a matter of law and plaintiff's patent is invalid for this reason. Plaintiff responds to this argument with the observation that defendant suggested no offer of proof on this issue. What plaintiff fails to recognize is that the question of obviousness is a question of law. Plaintiff's evidence of patent validity over Gonzalez is limited to testimony from his witnesses that his patent structure discloses a "cammed surface" rather than a flange (T. 2735-2739, 2756-2757, 2759, 2760-2761, 2763-2764, 2800). This testimony, irrelevant because plaintiff does not claim a "cammed surface," nevertheless, could not be a patentable improvement because it is shown in the prior art. Thus, Carpenter discloses this very cammed surface in his patent specification (SA 86, ll. 44-46) and structure (DX 37, SA 84) and plaintiff's witnesses concede the shape of the Gonzalez pin can be altered (T. 2737-2738). Defendant does not understand what additional offer of proof was required or would be appropriate.

For these reasons, too, defendant respectfully requests that a writ of certiorari issue.

CONCLUSION.

For each of the reasons set forth above, and those set forth in its Petition, petitioner respectfully prays that this Court issue a writ of certiorari and thereafter rule that the judgments of the United States Court of Appeals for the Seventh Circuit and of the United States District Court for the Northern District of Illinois must be reversed, and that judgment be entered for defendant. Alternatively, upon reversal of these judgments, this matter should be remanded to the District Court for a new trial.

Respectfully submitted,

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